



MAR 30 2009

Facsimile Cover Sheet

Patent Department

TODAY'S DATE: March 30, 2009**PLEASE DELIVER THE FOLLOWING MESSAGE TO:**

Office of Petitions
 Examiner: Kamal A. Saeed
 Fax No.: 571-273-8300

THIS MESSAGE IS FROM:

Name: Richard C. Billups
 Phone No.: (732)594-4683 Mail Location: RY60-30
 Fax No.: (732)594-2300

Appl'n. No.: 10/556,230
 Filing Date: November 9, 2005
 Docket No.: 21241P
 For: BENZIMIDAZOLES, COMPOSITIONS CONTAINING SUCH COMPOUNDS
 AND METHODS OF USE

NUMBER OF PAGES BEING TRANSMITTED (INCLUDING COVER): 5

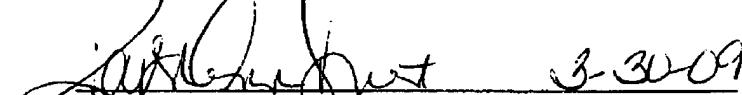
Documents sent:

Cover Sheet (1pg.) and Petition (3 pgs.) and Fee Transmittal (1 pg)

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--------------|--|------------------|-----------------------------|
| Applicants: | Emma R. Parmee et al. | Case No.: 21241P | Art Unit: 1626 |
| Serial No.: | 10/556,230 | | Examiner: Kamal A. Saeed |
| Filing Date: | November 9, 2005 | | |
| For: | BENZIMIDAZOLES, COMPOSITIONS CONTAINING SUCH COMPOUNDS AND METHODS OF USE | | |

Office of Petitions
Honorable Commissioner of Patents
Alexandria, VA 22313-1450

PETITION PURSUANT TO 37 C.F.R. § 1.181 AND
APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705

Sir:

This Petition is filed pursuant to 37 C.F.R. § 1.705 seeking reconsideration of the period of patent term adjustment awarded by the Patent Office in the captioned patent application.

STATEMENT OF FACTS

- 1) The captioned patent application is a U.S. National Phase application filed under 35 USC 371. The U.S. National Phase filing date was November 9, 2005.
- 2) The Patent Office issued a Restriction Requirement on September 5, 2008, 605 days after the filing date. The 14-month cutoff for purposes of calculating delay under 37 CFR 1.703(a)(1) is January 7, 2007. The PTO calculation of delay as 605 days was correct.
- 3) A response to the Restriction Requirement dated September 5, 2008 was filed via facsimile on October 2, 2008.

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- 4) Applicants also submitted an IDS on March 26, 2007, and a second IDS on November 26, 2007, via regular U.S. mail. The first IDS and references were indicated as received in the Patent Office on March 27, 2007. The second IDS was received in the Patent Office on November 28, 2007.
- 5) The Patent Office issued a Restriction Requirement on September 5, 2008. Applicants responded to the Restriction Requirement on October 10, 2008 via facsimile.
- 6) A Notice of Allowance was mailed by the Patent Office on December 30, 2008. The Issue Fee is due March 30, 2009. The Issue Fee is being submitted to the Patent Office with this Petition.
- 7) This patent is not subject to a terminal disclaimer.
- 8) There were no instances in which Applicants failed to respond to an Official Action within the prescribed time frame. Consequently, a fee as set forth in 37 C.F.R. § 1.18(f) and a showing of the use of "all due care" under 37 C.F.R. § 1.705(c)(2) are not required.

ARGUMENTS IN SUPPORT OF PETITION

The Patent Office has not provided any indication of patent term adjustment for delay beyond the date that is three years after the 371(c) filing or completion date, i.e., no determination has been made taking into account delay under 37 C.F.R. § 1.703(b).

Under *Wyeth v. Dudas*, No. 07-1492 (D.D.C. 2008), a patentee is entitled to both any "(a) period" delay and any "(b) period" delay. According to *Wyeth*, 35 U.S.C. § 154 establishes that a patent term is 20 years from the earliest relevant filing date of a patent application. Because patentees do not benefit from patent term during prosecution, § 154(b)(1) further provides a patent term adjustment (PTA) to account for delays by the Patent Office under certain circumstances. For example, the statute provides a one-day extension of term for every day corresponding to an "(a) delay," that is, where the Patent Office fails to meet particular deadlines such as issuing a first Office Action within 14 months, responding to a reply within four months, and so forth. In addition, the statute addresses a "(b) type delay" by giving a one-day extension of term for every day of prosecution that occurs three years after the filing date.

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To prevent double-counting, 35 U.S.C. § 154 dictates that, *to the extent that "(a) delays" and a "(b) delay" overlap, the patent term adjustment "shall not exceed the actual number of days the issuance of the patent was delayed."* § 154(b)(2)(A). (emphasis added). The Patent Office has interpreted this language to mean that a patentee may obtain credit for "(a) delays" or a "(b) delay," whichever is larger, but not (a) + (b). According to the Patent Office prior to Wyeth, any period of "(b) delay" necessarily overlaps with any periods of "(a) delays." The District Court in Wyeth held that only actually overlapping days should be subtracted.

Since the three year date for this application occurred on November 9, 2008, and since there were no type (a) delays by the Patent Office after this date, the (b) period can be calculated as a day-for-day extension from November 9, 2008, until the date that the patent issues, less any time that the Patent Office deems Applicants to have been non-diligent in advancing prosecution.

CONCLUSION

Applicants urge that the correct Patent Term Adjustment is 605 days plus the full period of time calculated from the date that is the three years after the filing date, i.e., November 9, 2008, until the patent is granted.

Enclosed herewith is an authorization to charge deposit account 13-2755 the \$200.00 fee required under § 1.18(e).

Respectfully submitted,

By


Richard C. Billups, Reg. No. 31,918
Attorney for Applicants

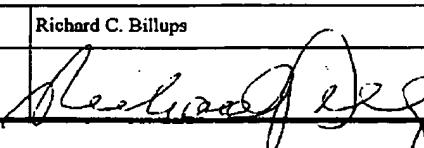
MERCK & CO., Inc.
P.O. Box 2000
Rahway, New Jersey 07065-0907
Tel: (732)594-4683

Date: March 30, 2009

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| MISC. FEE TRANSMITTAL | | <i>Complete if Known</i> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
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| <i>Patent fees are subject to annual revision.</i> | | Application Number | 10/556,230 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| | | Filing Date | November 9, 2005 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| | | First Named Inventor | Emuna R. Parmee | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| | | Examiner Name | Kamal A. Saeed | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| | | Group Art Unit | 1626 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| | | Attorney Docket Number | 21241P | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| METHOD OF PAYMENT | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| <input checked="" type="checkbox"/> Deposit Account Deposit Account Number <input type="text" value="13-2755"/> Deposit Account Name <input type="text" value="Merck & Co., Inc."/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| The Director is authorized to: <input checked="" type="checkbox"/> Charge fee(s) indicated below <input checked="" type="checkbox"/> Credit any overpayments <input checked="" type="checkbox"/> Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| FEES CALCULATION | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th colspan="2" style="text-align: left; padding-bottom: 5px;">FEES Large Entity</th> <th colspan="2"></th> </tr> <tr> <th style="text-align: left;">Fee Code</th> <th style="text-align: left;">Fee (\$)</th> <th style="text-align: left;">Fee Description</th> <th style="text-align: right;">Fee Paid</th> </tr> </thead> <tbody> <tr> <td style="text-align: left;">1051</td> <td style="text-align: left;">130</td> <td>Surcharge - late filing fee or oath</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1053</td> <td style="text-align: left;">130</td> <td>Non-English Specification</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1812</td> <td style="text-align: left;">2,520</td> <td>For filing a request for <i>ex parte</i> reexamination</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1402</td> <td style="text-align: left;">540</td> <td>Filing a brief in support of an appeal</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1452</td> <td style="text-align: left;">540</td> <td>Petition to revive - unavoidable</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1453</td> <td style="text-align: left;">1,620</td> <td>Petition to revive - unintentional</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1807</td> <td style="text-align: left;">50</td> <td>Processing fee under 37 CFR 1.17(q)</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1806</td> <td style="text-align: left;">180</td> <td>Submission of Information Disclosure Statement</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1809</td> <td style="text-align: left;">810</td> <td>Filing a submission after final rejection (37 CFR 1.129(a))</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1810</td> <td style="text-align: left;">810</td> <td>For each additional invention to be examined (37 CFR 1.129(b))</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td style="text-align: left;">1814</td> <td style="text-align: left;">140</td> <td>Statutory Terminal Disclaimer under 37 CFR 1.321</td> <td style="text-align: right;"><input type="text"/></td> </tr> <tr> <td colspan="2" style="text-align: left; padding-top: 10px;">Other fee (specify)</td> <td colspan="2" style="text-align: right; padding-top: 10px;"><u>Request for Reconsideration of the Patent Term Adjustment</u> <input style="width: 150px; border: 1px solid black; height: 15px; vertical-align: middle;" type="text"/></td> </tr> <tr> <td colspan="2" style="text-align: left; padding-top: 10px;">Other fee (specify)</td> <td colspan="2" style="text-align: right; padding-top: 10px;"><input style="width: 150px; border: 1px solid black; height: 15px; vertical-align: middle;" type="text"/></td> </tr> <tr> <td colspan="4" style="text-align: right; padding-top: 20px;">TOTAL <input type="text" value="\$200"/></td> </tr> </tbody> </table> | | | | FEES Large Entity | | | | Fee Code | Fee (\$) | Fee Description | Fee Paid | 1051 | 130 | Surcharge - late filing fee or oath | <input type="text"/> | 1053 | 130 | Non-English Specification | <input type="text"/> | 1812 | 2,520 | For filing a request for <i>ex parte</i> reexamination | <input type="text"/> | 1402 | 540 | Filing a brief in support of an appeal | <input type="text"/> | 1452 | 540 | Petition to revive - unavoidable | <input type="text"/> | 1453 | 1,620 | Petition to revive - unintentional | <input type="text"/> | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | <input type="text"/> | 1806 | 180 | Submission of Information Disclosure Statement | <input type="text"/> | 1809 | 810 | Filing a submission after final rejection (37 CFR 1.129(a)) | <input type="text"/> | 1810 | 810 | For each additional invention to be examined (37 CFR 1.129(b)) | <input type="text"/> | 1814 | 140 | Statutory Terminal Disclaimer under 37 CFR 1.321 | <input type="text"/> | Other fee (specify) | | <u>Request for Reconsideration of the Patent Term Adjustment</u> <input style="width: 150px; border: 1px solid black; height: 15px; vertical-align: middle;" type="text"/> | | Other fee (specify) | | <input style="width: 150px; border: 1px solid black; height: 15px; vertical-align: middle;" type="text"/> | | TOTAL <input type="text" value="\$200"/> | | | |
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| Fee Code | Fee (\$) | Fee Description | Fee Paid | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| 1051 | 130 | Surcharge - late filing fee or oath | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| 1053 | 130 | Non-English Specification | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| 1812 | 2,520 | For filing a request for <i>ex parte</i> reexamination | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| 1402 | 540 | Filing a brief in support of an appeal | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| 1452 | 540 | Petition to revive - unavoidable | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
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| 1807 | 50 | Processing fee under 37 CFR 1.17(q) | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| 1806 | 180 | Submission of Information Disclosure Statement | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
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| 1810 | 810 | For each additional invention to be examined (37 CFR 1.129(b)) | <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
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| TOTAL <input type="text" value="\$200"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| SUBMITTED BY | | | <i>Complete (if applicable)</i> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| Typed or Printed Name | Richard C. Billups | | Reg. Number <input type="text" value="31,916"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
| Signature |  | Date <input type="text" value="03/30/2009"/> | Deposit Account User ID <input type="text"/> | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |